

REMARKS

Reconsideration and allowance are respectfully requested in view of the foregoing amendments and the following remarks.

Claims 1-49 are pending in this application.

Claim 25 has been amended.

Claims 30-49 have been indicated as allowed.

Regarding the Claim Objections

Claim 25 was objected to because of a minor informality. Applicant appreciates the Examiner's close reading of the claims and has made the appropriate correction indicated by the Examiner. Applicant respectfully submits that no new matter has been added and that the Amendment to claim 25 is not intended to narrow the claim in any way, but rather to correct a typographical claim drafting error. Applicant respectfully requests that the objection be withdrawn.

Regarding the § 103 Rejection

Claims 1, 26 and 27 were rejected under 35 U.S.C. § 103(a) as being rendered obvious by Michel, et al. (U.S. Patent No. 6,658,607) in view of Michel, et al. (U.S. Patent No. 6,591,383). Applicant respectfully traverses this rejection.

Applicant respectfully points out that the Federal Circuit requires that some motivation or suggestion must be found in the prior art or other evidence of record that would have lead one of ordinary skill in the art to produce the claimed invention in order to properly establish a *prima facie* case of obviousness. Applicant respectfully submits that a *prima facie* case of obviousness has not been made. The CCPA explained how it would evaluate a *prima facie* case of

obviousness in *in re Clinton*, 527 F2nd 1226, 188 USPQ 365 (CCPA 1976). The court required that “first one must look at the references to determine whether the references by themselves...suggest doing what the inventor has done.” The court next considered whether a person of ordinary skill in the art would, based on the cited art, have had sufficient basis for the required expectation of success. Applicant respectfully points out that neither Michel ‘607 nor Michel ‘383 teach, allude to, or render obvious anything similar to “performing an operation using the correction value in the portion of the selected data, thereby yielding a replacement value; and making the portion of the selected data equal to the replacement value, thereby yielding adjusted selected data.”

Applicant agrees with the Examiner that Michel ‘607 does not teach, allude to or render obvious performing an operation using the correction value to create a replacement value thereby yielding adjusted selected data. Applicant further submits that although Michel ‘383 discloses a method for bit error rate detection wherein the bit error rate is determined. Col. 9, line 1 through Col. 10, line 5. Applicant points out that Michel ‘383 does not make a portion of the selected data equal to the replacement value, thereby yielding adjusted selected data. Michel ‘383 does not teach, allude to, or render obvious the insertion of corrected data into the frames of data in order to prevent the generation of BIP mismatches. Both Michel ‘607 and ‘383 do not provide any motivation or suggestion that would have led one of ordinary skill in the art to produced the claimed invention because there is no suggestion of “making the portion of the selected data equal to the replacement value, thereby yielding adjusted selected data.” Furthermore, in *re Vaeck*, 947 F2nd 488 further requires that for a *prima facie* case of obviousness to exist, there must be a reasonable expectation of success wherein the prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make

the claimed combination and their reasonable expectation of success must both be found in the prior art and not based on the Applicant's disclosure. *Id.* Applicant respectfully points out that the cited art does not combine nor suggest that the combination of references would provide "making a portion of the selected data equal to the replacement value, thereby yielding adjusted selected data." As such, Applicant respectfully submits that a *prima facie* case of obviousness has not been presented and requests that the § 103 rejection be withdrawn with respect to claims 1, 26 and 27. Applicant respectfully submits that these claims are ready for allowance.

Claims 28 and 29 were rejected under 35 U.S.C. § 103(a) as being rendered obvious by Michel et al '607 in view of Michel et al '383 and further in view of Diasonescu et al (U.S. Patent No. 6,738,395). Applicant submits that claims 28 and 29 are either directly or indirectly dependent upon claim 1 and that the Diasonescu reference does not alleviate the lack of a *prima facie* case of obviousness discussed above with respect to the Michel '607 and Michel '383 references. Applicant respectfully requests that the § 103 rejection be withdrawn and submits that claims 28 and 29 are ready for allowance.

Regarding the Allowable Subject Matter

Applicant appreciates the Examiner's indication that claims 30-49 are allowable.

Applicant also greatly appreciates the Examiner's indication that claims 2-25 would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims. Applicant respectfully submits that such a rewriting of claims 2-25 is not necessary based on the lack of a *prima facie* case of obviousness discussed above with respect to claim 1. Applicant respectfully submits that claims 2-25 are now ready for allowance.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Dated: Aug 30, 2004

Respectfully submitted,

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